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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/748,695 | 12/30/2003 | Robert Coon | WEAT/0535 | 2005 |
| 36735 | 7590 | 08/09/2005 | EXAMINER | |
| MOSER, PATTERSON & SHERIDAN, L.L.P. 3040 POST OAK BOULEVARD, SUITE 1500 HOUSTON, TX 77056-6582 | | | COLLINS, GIOVANNA M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3672 | |

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,695

Applicant(s)

COON ET AL.

Examiner

Giovanna M. Collins

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3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20050404.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Information Disclosure Statement

The references cited in the Search Report for Application No. EP 04030243, dated March 9, 2005 have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO/SB/08A and 08B form, must be filed within the set period for reply to this Office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3,8,10-13, and 16-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Coon et al 5,309, 993.

Coon discloses (fig. 4-8)a tool for use in a wellbore, comprising: a tubular housing (119) having a bore therethrough and at least one flow port disposed through a wall thereof (106), a sleeve (111) slidably mounted within the housing, wherein the sleeve has a bore therethrough and at least one flow slot (116) disposed through a wall thereof, the at least one slot selectively alignable with the at least one flow port; and a seal assembly (109) disposed between the housing and the sleeve, wherein the seal

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assembly is configured so that a first portion of the seal assembly protects a second portion of the seal assembly from substantial damage during actuation of the tool.

Referring to claim 2, Coon discloses the length of the seal assembly (109) substantially corresponds to the length of the sleeve flow slot.

Referring to claim 3, Coon discloses (fig. 11) the seal assembly comprises a center adapter (306).

Referring to claims 8 and 13, Coon discloses a first end adapter (303), a second end adapter (309), the center adapter between the two end adapters; at least one first sealing element (305) between the first end adapter and the center adapter and a second sealing element (307) between the second end adapter and the center adapter.

Referring to claims 10, Coon discloses at least one equalization slot (see Fig. 4, at end of element 106) smaller than the flow slot.

Referring to claim 11, Coon discloses means for selectively retaining the sleeve among a closed, an open and an equalization position (col. 5, line 58- col. 6, line 22).

Referring to claim 12, Coon discloses the housing comprises an upper housing (103) and a lower housing (119) threaded together and one of the housing comprises a lip and the other housing comprises a tapered surface so that the lip mates with the tapered surface to form a seal (at 105).

Referring to claim 16, Coon discloses the adapters are constructed from relatively hard material and the sealing members are constructed from a relatively soft material (col. 16, lines 53-68).

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Referring to claim 17-18, Coon discloses the adapters are constructed from thermoplastic polymer or metal and the sealing elements are construction from a thermoplastic polymer or elastomer (col. 16, lines 53-68).

Referring to claim 19, Coon discloses the sealing members (305,307) are Chevron-shaped.

Referring to claim 20, Coon discloses a tool for use in a wellbore, comprising a tubular housing having a bore therethrough and at least one flow port (106) disposed through a wall thereof, a sleeve (111) slidably mounted within the housing, wherein the sleeve has a bore therethrough and at least one flow slot (106) disposed through a wall thereof, the at least one slot selectively alignable with the at least one flow port; and a seal assembly (109) comprising a center adapter (306), wherein the center adapter includes a structure configured for limiting fluid flow across the seal assembly during actuation of the tool.

Referring to claim 21, Coon discloses a method of using a wellbore tool in a pressurized wellbore, comprising: providing the wellbore tool, wherein the tool comprises: a tubular housing (119) having a bore therethrough and at least one flow port (106) disposed through a wall thereof, a sleeve (111) slidably mounted within the housing, wherein the sleeve has a bore therethrough and at least one flow slot disposed through a wall thereof, and a seal assembly (109) disposed between the housing and the sleeve, running the wellbore tool into a pressurized wellbore, and sliding the sleeve over the seal assembly, wherein a first portion of the seal assembly will restrict flow of

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pressurized fluid to a second portion of the seal assembly so that the second portion is not substantially damaged during sliding of the sleeve.

Referring to claim 22, Coon discloses a method of using a wellbore tool in a pressurized wellbore, comprising: providing the wellbore tool, wherein the tool comprises: a tubular housing (119) having a bore therethrough and at least one flow port (106) disposed through a wall thereof, a sleeve (111) slidably mounted within the housing, wherein the sleeve has a bore therethrough and at least one flow slot disposed through a wall thereof, the at least one slot selectively alignable with the at least one flow port; and a seal assembly comprising a center adapter, wherein the center adapter includes a structure', running the wellbore tool into a pressurized wellbore', and sliding the sleeve over the seal assembly, wherein the structure of the center adapter will limit fluid flow across the seal assembly so that the seal assembly is not substantially damaged during sliding of the sleeve.

2. Claims 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Baugh 5,611,547.

Referring to claim 13, Baugh discloses (fig. 3) a first end adapter (112), a second end adapter (108), and a the center adapter (at 92) between the two end adapters; at least one first sealing element (at 110) between the first end adapter and the center adapter and a second sealing element (at 106) between the second end adapter and the center adapter.

Referring to claims 14-15, Baugh discloses a plurality of protrusions (120) around the center adapter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coon '993 in view of Baugh '547.

Coon does not disclose the length of the center adapter corresponds to the length of a flow slot. Baugh teaches a center adapter that has a length that corresponds with a flow slot. Baugh teaches that this design helps to prevent counter clockwise flexing (col. 7, lines 4-12). As it would be advantageous to help to reduce counter clockwise flexing, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the tool disclosed by Coon to have the center adapter have a length that corresponds with a flow slot as taught by Baugh.

Referring to claims 5-7, Coon does not disclose protrusions on the center adapter. Baugh teaches a plurality of protrusions around and inner and outer side of a center adapter. Baugh teaches the protrusions help to reduce tearing and abrading the adapter as it is installed (col. 6, lines 17-26). As it would be advantageous to prevent tearing the adapter, it would be obvious to one of ordinary skill in the art at the time of

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the invention to modify the tool disclosed by Coon to have the center adapter have protrusions as taught by Baugh.

Referring to claim 9, Coon does not disclose protrusions on the first end adapter. Baugh teaches a protrusion on an adapter. Baugh teaches the protrusion provides backup sealing (col. 5, lines 38-40). As it would be advantageous to have backup sealing it would be obvious to one of ordinary skill in the art at the time of the invention to modify the tool disclosed by Coon to have the center adapter have protrusions as taught by Baugh.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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